

REMARKS

This application has been reviewed in light of the Office Action dated February 26, 2004. Claims 1-16 are presented for examination. Claims 1 and 15 have been amended to define more clearly what Applicant regards as the invention. Claims 1, 3, 15 and 16 are in independent form. Favorable reconsideration is requested.

Applicant notes with appreciation the indication that Claim 14 would be allowable if rewritten so as not to depend from a rejected claim, and with no change in scope. The latter claim has not been so rewritten because, for the reasons given below, its base claim is believed to be allowable.

Claims 1, 2 and 15 were rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,131,136 (“Liebenow”). Claims 3, 4, 6, 11, 13 and 16 were rejected under 35 U.S.C. § 103(a) as being obvious from Liebenow in view of U.S. Patent No. 5,684,608 (“Charbonnier”); Claim 5 as obvious from Liebenow in view of Charbonnier and U.S. Patent No. 6,223,061 (“Dacus”); Claims 7 and 8 as obvious from Liebenow in view of Charbonnier and U.S. Patent No. 6,072,803 (“Allmond”); Claims 9 and 10 as obvious from Liebenow in view of Charbonnier and U.S. Patent No. 5,517,552 (“Yamashita”); and Claim 12 as obvious from Liebenow in view of Charbonnier and U.S. Patent No. 5,479,485 (“Hayashi”).

Claim 1

The aspect of the present invention set out in independent Claim 1 is a communication apparatus having a wired communication unit and a wireless communication unit having a plurality of wireless communication modes. The communication apparatus includes determining means for determining a connecting

condition of the wired communication line and an input means for a user to use in inputting transmission data. A communication means is provided for selectively transmitting the transmission data inputted by the input means via one of the wired communication unit and the wireless communication unit, and selecting a wireless communication mode of the plurality of wireless communication modes of the wireless communication unit in accordance with the determination by the determining means.

One important aspect of these claimed features is that the communication means is configured to select a wireless communication mode from among the plurality of wireless communication modes depending upon the connecting condition of the wired communication line.

As discussed, for example, at page 24, lines 15-24, of the specification, when a facsimile device (FS1) is connected to an ISDN, a master station digital wireless communication protocol for a telephone handset (PHS) may be selected, whereas when the facsimile device (FS1) is not connected to the ISDN, a remote station digital wireless communication protocol for a wireless switchboard (RC1) may be selected. Of course, this example is but one embodiment of this aspect of the invention and does not limit the scope of the claims.

By contrast, Liebenow relates to a dual-mode modem (100) having mode selection circuitry (101) for selecting between a wire-based communication network (105) and a wireless communication network (107). The mode selecting circuitry (101) consists of switching circuitry (113) and detection circuitry (115). When the detection circuitry (115) detects that the modem is attached to the wire-based communication network (105), the switching circuitry (113) switches to the wired interface (111), and when the detection circuitry (115) detects that the modem (100) is not attached to the wire-based

communication network (105), the switching circuitry (113) switches to the wireless interface (109). The wireless interface is not powered when the modem is coupled to the wire-based communication network (see abstract).

Nothing has been found in Liebenow that teaches or suggests a plurality of wireless communication modes. Rather, Liebenow simply selects between a wired interface and a wireless interface. *A fortiori*, nothing has been found in Liebenow that teaches or suggests a communication means for selecting a wireless communication mode from among a plurality of wireless communication modes depending upon the connecting condition of the wired communication line, as recited in Claim 1.

Accordingly, Claim 1 is believed to be patentable over Liebenow.

### Claim 3

The aspect of the present invention set out in independent Claim 3 is a communication apparatus having a first mode, for performing wireless communication under the control of a first wireless communication apparatus, and a second mode, for controlling so that a second wireless communication apparatus performs wireless communication. The communication apparatus includes determining means for determining whether a wired communication line is connected to the communication apparatus. A control means is provided for automatically switching between the first mode and the second mode in accordance with the determination by the determining means.

As acknowledged in the Office Action, Liebenow does not teach or suggest a communication apparatus having a first mode, for performing wireless communication under the control of a first wireless communication apparatus, and a second mode, for controlling so that a second wireless communication apparatus performs wireless

communication, as recited in Claim 3. The Examiner turns instead to Charbonnier for this feature.

Charbonnier relates to a facsimile apparatus that can perform wireless communication either in a handset mode, in which it acts as a cordless facsimile device that communicates with a telephone base station connected to a telephone line, or in a base mode, in which it is connected to a telephone line and acts as the base station for a cordless handset. Even assuming, *arguendo*, that Charbonnier's handset mode and base mode correspond to the claimed first and second modes and that one of ordinary skill in the art would have been motivated to combine Liebenow and Charbonnier in the manner hypothesized by the Examiner, it is respectfully submitted that the resulting combination still would not teach or suggest the features of Claim 3 for the following reason.

In Applicant's view, nothing in Charbonnier teaches or suggests a control means for automatically switching between a first wireless mode and a second wireless mode in accordance with a determination by a determining means as to whether a wired communication line is connected to the communication apparatus, as recited in Claim 3. Rather, Charbonnier merely states that certain components switch operating modes “[w]hen the mode of use of the system is changed from the telephone handset mode into base mode or conversely. . .” See Charbonnier at col. 2, lines 59-64.

The Examiner posits that such a control means for automatic switching between wireless communication modes is taught by Liebenow. However, Liebenow actually is concerned with switching between a wireless communication mode and a wire-based communication mode based on the presence of a wired connection. In fact, when a wired connection is detected in Liebenow, power to the wireless interface is shut off. Thus, even if one were to combine Liebenow and Charbonnier, the resulting combination

still would not teach or suggest a control means for automatically switching between a first wireless mode and a second wireless mode in accordance with a determination by a determining means as to whether a wired communication line is connected to the communication apparatus, as recited in Claim 3.

More fundamentally, Applicant respectfully submits that the Examiner has not met the burden of explaining why one of ordinary skill in the art would have been motivated to combine Liebenow and Charbonnier.

The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. “To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.”

M.P.E.P. §2142 (quoting *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985). In this regard, the Examiner states that “Liebenow et al. suggest it is desired to provide that a dual mode modem automatically switches between a wireless and wire-based communication.” Office Action at 5 (emphasis added). But as discussed above, Claim 3 recites a control means for automatically switching between a first wireless mode and a second wireless mode.

The Examiner further states that the motivation for combining Liebenow and Charbonnier would have been “to provide an automatically switching between modes in a dual mode modem apparatus in order to have a great flexibility and very efficient communication apparatus.” Office Action at 5. But this rationale goes well beyond what Liebenow fairly teaches to one of ordinary skill in the art. As discussed at length above, Liebenow is concerned with switching between a wireless communication mode and a

wire-based communication mode based on the presence of a wired connection, rather than switching between two wireless modes.

Moreover, the cited portions of Charbonnier extolling the flexibility and efficiency of the device disclosed in that reference do not in any way suggest that it would be desirable to include a means for switching between a wireless communication mode and a wire-based communication mode. It is therefore respectfully submitted that the Examiner's rationale for combining Liebenow and Charbonnier fails to rise to the level of a "convincing line of reasoning," and therefore *prima facie* obviousness has not been established.

For at least these reasons, Claim 3 is believed to be patentable over the combination of Liebenow and Charbonnier.

Independent Claims 15 and 16 recite features similar to those discussed above with respect to Claims 1 and 3, respectively, and therefore are also believed to be patentable over the cited art for the reasons discussed above.

A review of the other art of record, including Allmond, Yamashita, Hayashi and Dacus, has failed to reveal anything which, in Applicant's opinion, would remedy the deficiencies of the art discussed above, as references against the independent claims herein. Those claims are therefore believed patentable over the art of record.

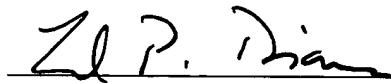
The other claims in this application are each dependent from one or another of the independent claims discussed above and are therefore believed patentable for the same reasons. Since each dependent claim is also deemed to define an additional aspect of the invention, however, the individual reconsideration of the patentability of each on its own merits is respectfully requested.

This Amendment After Final Action is believed clearly to place this application in condition for allowance and, therefore, its entry is believed proper under 37 C.F.R. § 1.116. Accordingly, entry of this Amendment After Final Action, as an earnest effort to advance prosecution and reduce the number of issues, is respectfully requested. Should the Examiner believe that issues remain outstanding, it is respectfully requested that the Examiner contact Applicant's undersigned attorney in an effort to resolve such issues and advance the case to issue.

In view of the foregoing amendments and remarks, Applicant respectfully requests favorable reconsideration and early passage to issue of the present application.

Applicant's undersigned attorney may be reached in our New York office by telephone at (212) 218-2100. All correspondence should continue to be directed to our below listed address.

Respectfully submitted,

  
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